

REMARKS

By this Amendment, Applicant proposes canceling claims 1, 8, 10, 12, 14, 21, 23, 25, and 27 without prejudice or disclaimer of the subject matter thereof. Upon entry of these amendments, claims 2-7, 9, 11, 13, 15-20, 22, 24, 26, and 28 will be pending in this application.

In the Final Office Action,¹ the Examiner rejected claims 1-7, 12-20, and 25-28 under 35 U.S.C. § 102(b) as being anticipated by Buchanan et al. (U.S. Patent No. 5,267,155); rejected claims 8, 9, 21, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Buchanan in view of Van Huben et al. (U.S. Patent No. 6,327,594); and rejected claims 10, 11, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Buchanan et al. in view of Salas et al. (U.S. Patent No. 6,233,600).

Applicant respectfully traverses the rejection of claims 1-7, 12-20, and 25-28 under 35 U.S.C. § 102(b) as anticipated by Buchanan, and notes that since claims 1, 12, 14, 25, and 27 have been canceled, the rejection with respect to these claims is moot.

To properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(b), the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.”

M.P.E.P. § 2131 (8th ed. Aug. 2001), p. 2100-69.

Claim 2 recites a combination including, among other things, “an identification information extracting module for extracting the identification information by scanning the first data to be used by application software; a search information extracting module for extracting the first search information corresponding to the extracted identification information by referring to the search information storage module” and “a data extracting module for extracting second data by searching a database on the basis of the extracted first search information.” Buchanan at least does not disclose the claimed combination including these features.

In the Buchanan system, to use a document template, a user selects a type of report to generate. See col. 5, lines 13-14. The document template associated with the report is retrieved from nonvolatile memory and computing device 10 begins to evaluate each “hole” in the template. See col. 5, lines 13-17. Evaluation consists of scanning the document template for variable identifiers. See col. 5, lines 17-18. When computing device 10 finds the first variable identifier in the document template being evaluated, it lists the phrases contained in the option-text record associated with the variable identifier. See col. 5, lines 19-22. Next, the user selects one or more of the phrases displayed, the selections are recorded, and computing device 10 moves to the next variable identifier. See col. 5, lines 22-25.

However, Buchanan does not teach “a search information extracting module for extracting the first search information corresponding to the extracted identification information by referring to the search information storage module,” as recited in claim 2.

The Examiner contends that the claimed “search information extracting module” is taught by Buchanan at col. 5, lines 27-30. Applicant disagrees. While lines 27-30 of column 5 disclose formatting of variable identifiers, the Examiner’s citation is silent as to Applicant’s claimed “search information extracting module.” Accordingly, the rejection of claim 2 is improper for at least this reason.

Additionally, the Examiner apparently contends that the variable identifiers disclosed in Buchanan correspond to the claimed identification information, and the character strings associated with such variable identifiers constitutes the claimed second data. Claim 2, however, recites that the data extracting module extracts the second data by searching a database on the basis of extracted *first search information*, not the claimed identification information. In contrast, in Buchanan, the character strings (allegedly the “second data”) are obtained based on the variable identifiers (allegedly the “identification information”) themselves. Since the reference does not disclose extracting character strings based on *other* information corresponding to the variable identifiers, Buchanan fails to teach the claimed data extracting module “for extracting second data by searching a database on the basis of the *extracted first search information*,” as recited in claim 2 (emphasis added).

Moreover, Fig. 3A of Buchanan illustrates an embodiment of option-text data file 24. Option-text data file 24 comprises option-text data records 36 in which are stored a plurality of character strings 34. See col. 6, lines 10-12. Each record 36 corresponds to a specific option-text variable 30 in document template 22. See col. 6, lines 12-14. Character strings 34 are strings formed from a unique option-text variable identifier 37, which is used to associate a record 36 with its option-text variable 30. See col. 6, lines

14-17. This permits the use of an option-text variable 30 in more than one document template 22. See col. 6, lines 17-18. Therefore, according to Buchanan, option-text data file 24 is directly related to option-text variable 30. As a result, option text data file 24 is structured as a dedicated file that is used by a word processing system. An advantage of Applicant's claimed invention, as recited in claim 2, is that a dedicated database is not required.

Furthermore, because claim 2 recites "a search information extracting module for extracting the first search information corresponding to the extracted identification information by referring to the search information storage module" and "a data extracting module for extracting second data by searching a database on the basis of the extracted first search information," a further advantage of the claimed arrangement is that a search can be conducted in two steps, which enables the use of search data by application software that is separate from the database. In Buchanan, however, a search is conducted in one step by referring to option text data file 24 and obtaining character strings 34 based on option-text variable 30. Therefore, in the Buchanan system, due to conducting a search in one step, option-text data file 24 cannot be stored separately from the option-text variable 30. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claim 2 for at least these additional reasons.

Independent claim 15, while of a different scope, includes recitation similar to allowable claim 2. For example, claim 15 recites a method including, among other steps, "a search information extracting step of referring to search information storage module for storing first information for searching a database in association with

identification information, thereby extracting the first search information corresponding to the extracted identification information” and “a data extracting step of searching a database on the basis of the extracted first search information, thereby extracting second data.” Accordingly, claim 15 is allowable at least for reasons discussed above with respect to claim 2.

Moreover, claims 3-7, 13, 16-20, 26, and 28 are allowable at least due to their dependence from claims 2 and 15.

Applicant respectfully traverses the rejection of claims 8, 9, 21, and 22 under 35 U.S.C. § 103(a) as unpatentable over Buchanan in view of Van Huben and the rejection of claims 10, 11, 23, and 24 under 35 U.S.C. § 103(a) as unpatentable over Buchanan in view of Salas. Since Applicant proposes canceling claims 8, 10, 21, and 23, the rejections with respect to these claims is moot.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must meet each of the following three requirements. First, the reference taken alone, or references combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, and not be based on applicant’s disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

According to the Examiner, Van Huben allegedly “teaches a common access method that enables disparate pervasive computers to interact with centralized data management systems (see abstract), in which he teaches wherein the application software is spreadsheet software and the first data is tabular data.” See Office Action, page 7. Also according to the Examiner, Salas allegedly “teaches wherein the application software is browser software and the first data is document data described in a structured tag language such as html.” See Office Action, page 8. Neither reference, however, teaches the claimed “search information extracting module for extracting the first search information corresponding to the extracted identification information by referring to the search information storage module” and “data extracting module for extracting second data by searching a database on the basis of the extracted first search information,” as recited in claim 2 and the steps of “a search information extracting step of referring to search information storage module for storing first information for searching a database in association with identification information, thereby extracting the first search information corresponding to the extracted identification information” and “a data extracting step of searching a database on the basis of the extracted first search information, thereby extracting second data,” as recited in claim 15. Accordingly, neither Van Huben nor Salas overcomes the above-noted shortcomings of Buchanan, and claims 9, 11, 22, and 24 are allowable at least due to their dependence from claims 2 and 15.

CONCLUSION

Applicant respectfully requests that the Examiner enter this Amendment under 37 C.F.R. § 1.116, placing the pending claims in condition for allowance. Applicant

submits that since the proposed amendments are limited to the cancellation of claims, this Amendment should allow for immediate entry by the Examiner.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 29, 2005

By: Anthony Y. Loh Reg. No. 53,232
for Richard V. Burgujian
Reg. No. 31,744